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DEC 26 2001

OFFICE OF PETITIONS

In re Application of
Horner-Richardson et al.
Application No. 09/821,868
Filed: March 30, 2001
Attorney Docket No. TDTD 10465.1

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition, filed October 10, 2001, under 37 C.F.R. §1.47(a).

The petition under 37 C.F.R. §1.47(a) is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on March 30, 2001, without an executed oath or declaration. Accordingly, on May 11, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set a two-month period for reply of July 11, 2001.

In reply, applicant filed a petition, petition fee and the surcharge for late filing of the declaration. To make timely the reply, a three month extension of time was also submitted. In support of the petition, applicants submitted the affidavit of Kevin D. Horner- Richardson, co-inventor, a copy of the assignment documents, correspondence to the non-signing inventor and a oath or declaration.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirements (1).

As to item (1), Rule 47 applicant has failed to show that the non-signing inventor refused to sign the declaration after having been presented with the application papers. The certified letter mailed to the non-signing inventor Small only indicates the

declaration and assignment documents were presented to the non-signing inventor. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The e-mail correspondence between declarant and non-signing inventor alone is not sufficient to establish “diligent effort”.

Thus on renewed petition, applicant must establish the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventor and he refused to sign.

Further correspondence with respect to this matter should be addressed as follows:

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

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